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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,433	01/15/2004	Horst Ulbricht	02481.1790-01	4111

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EXAMINER

FUBARA, BLESSING M

ART UNIT PAPER NUMBER

1615

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/757,433	Applicant(s) ULBRICHT ET AL.	
	Examiner Blessing M. Fubara	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/156,070.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01/15/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1615

DETAILED ACTION

Examiner acknowledges receipt of preliminary amendment, remarks and IDS filed

01/15/04. Claims 1-44 are pending.

Priority

Examiner acknowledges applicants' claim to prior application number 10/156,070 filed

05/29/2002.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4-6, 9, 10, 11, 15-18, 20-23, 26-28, 31, 33 and 41-43 rejected under 35 U.S.C. 102(b) as being anticipated by Wohlrab et al. (US 5,346,692).

Wohlrab discloses a nail lacquer that comprises film forming agent selected from the group consisting of cellulose acetate phthalate, cellulose acetate butyrate, cellulose acetate propionate, cellulose nitrate, cellulose sulfate, ethylcellulose and mixtures thereof; plasticizer, urea present in amounts of 15-60% (abstract and claim 6), clotrimazole, ethanol and acetone (claims 1-13 and abstract). Claim 1 teaches 30-50 wt.% aqueous ethanol. The comprising language of claim 1 does not exclude the presence of other components. The instant method applies the preparation to the affected area. The prior art's application of the composition to nail, which is keratinous meets the method where the method is a broad application. Wohlrab meets the limitations of the claims.

Art Unit: 1615

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (US 5,874,074).

Smith discloses a lotion composition comprising polyvinylpyrrolidone in amounts of 0.5-15 weight% (column 4, line 17; column 5, line 25 and claims 1 and 14), urea (column 5, line 7), water and anti-microbial agents in amounts 0.025-1 weight% (column 6, line 6). The composition of Smith is prepared as a lotion and applied to skin to treat warts among other skin disorder (column 7, lines 43-48). Specifically, Smith discloses salicylic acid and lactic acid as wart removing agents (column 5, line 10). Although, Smith's list does not list urea as a wart removing agent, salicylic acid and urea are disclosed as keratolytic agents and appear to be equivalent in their activities. Also, in column 7, lines 42-53, Smith specifically states "the lotions of the present invention may be used for treating a skin disorder or disease, such as psoriasis, eczema, atopic dermatitis, alopecia areata, warts, keratoses, acne, and the like. The lotion is spread over the diseased or irritated portion of the skin and allowed to dry to a film on the surface of the skin. The composition is then maintained on the skin surface for a predetermined period of time that is effective to deliver the therapeutic agent to the skin to provide the desired treatment of the skin disorder."

Art Unit: 1615

Treating or treatment of wart leads to the removal of the wart and thus treating warts broadly reads on removing or detaching warts, and specifically in light of a disclosure of wart removal or removing agent salicylic acid, which makes the lotion of Smith a lotion that has the capability to remove wart. Regarding the amount of the polyvinylpyrrolidone, it is within the purview of the person of ordinary skill in the art to optimize the lotion of Smith by including appropriate amount of polyvinylpyrrolidone to enhance the penetration of urea and to serve as occlusive film barrier.

Smith discloses a composition for treating or removing or detaching warts. Smith fails to disclose amounts of urea and failure to specifically disclose an amount of urea reflects that the amount of urea may be added to the composition as needed. However, amounts will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such amount is critical. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare and apply to the skin the lotion of Smith to treat wart. One having ordinary skill in the art would have been motivated to include an effective amount of urea with the expectation that application of the modified or optimized lotion of Smith to the skin would remove/treat/detach warts.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

Art Unit: 1615

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 17-24 and 26-29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-24 and 26-29 of copending Application No. 10/156,070. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims differ from the co-pending claims in that the co-pending claims recite solution and the instant claims do not exclude solution.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1615

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Blessing Fubara
Patent Examiner
Tech. Center 1600

A handwritten signature in black ink, appearing to read 'B. Fubara', is written over the printed name 'Blessing Fubara'.